

Notice of Allowability

Application No.

09/890,143

Examiner

Chih-Cheng Glen Kao

Applicant(s)

YAMAMOTO, MASAKI

Art Unit

2882

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/27/05.
2. ☒ The allowed claim(s) is/are 8-11 and 28-30.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

REASONS FOR ALLOWANCE

1. Claims 8-11 and 28-30 are allowed. The following is an examiner's statement of reasons for allowance.

2. Referring to applicant's appeal brief filed December 27, 2005, on pages 13 and 14, the examiner focused on a section from the brief stating that "[an] inventor may first file an application for a patent claiming a basic or generic invention and thereafter file a patent on an improvement on that basic invention.... [To] deny a patent may be unfair to the applicant who does not have complete control over the rate of progress of an application through the Patent Office."

In light of this remark, the examiner reviewed MPEP Section 804(II)(B)(1)(b) titled "Two-Way Obviousness", where it states that "[a] two-way test is to be applied only when the applicant could not have filed the claims in a single application and there is administrative delay." The examiner then went on to determine whether these two conditions were met with regards to the instant application. With regards to the first condition, the examiner determined that applicant could not have filed the claims in a single application, since the claims of the later filed applications (US Application Numbers 10/241,959 and 10/297,965) would not be supported by the instant application. With regards to the second condition, the broader claims of the instant application required a longer period of prosecution by the Patent Office, compared to the narrower claims of the later filed applications, which were allowed sooner. Since applicant did not have complete control over the rate of progress of the instant application, the examiner determined that the delay was inevitably administrative in nature. Since both of the above

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conditions were met with regards to the instant application, a two-way obviousness determination was required for the examiner, thus making the double patenting rejection, using only a one-way determination of obviousness, in the Office Action mailed March 3, 2005, improper and withdrawn by the examiner.

In light of this, the examiner used the Graham obviousness analysis twice to determine if there were still double patenting rejections to be made on the claims of the instant application. After analysis, the examiner determined that the claims of the later filed applications were patentably distinct from the claims of the instant application, since the later filed claims neither anticipate nor render obvious the claims of the instant application. Since this analysis did not compel a conclusion of obviousness, no double patenting of the obvious-type was made on claims 8-10 and 28-30. Therefore, all pending claims of the instant application are allowed by the examiner.

3. Regarding claim 8, prior art fails to disclose or fairly suggest a method for forming an optical element, including the steps of forming on a substrate a multilayer film consisting of a stack of alternating layers of high refractive index material and low refractive index material and adjusting a wavefront phase of emerging rays by cutting away a portion of the multilayer film stack in accordance with an amount of adjustment of the wavefront phase, in combination with all the limitations in the claim. Claims 9, 10, and 28-30 are allowed by virtue of their dependency.

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4. Regarding claim 11, prior art fails to disclose or fairly suggest a method for forming an optical element, including the steps of forming on a substrate a multilayer film consisting of a stack of alternating layers of high refractive index material and low refractive index material and cutting away a portion of a correction film and the multilayer film stack in accordance with an amount of adjustment of a wavefront phase of emerging rays, in combination with all the limitations in the claim.

Conclusion

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Cheng Glen Kao whose telephone number is (571) 272-2492. The examiner can normally be reached on M - F (9 am to 5 pm).

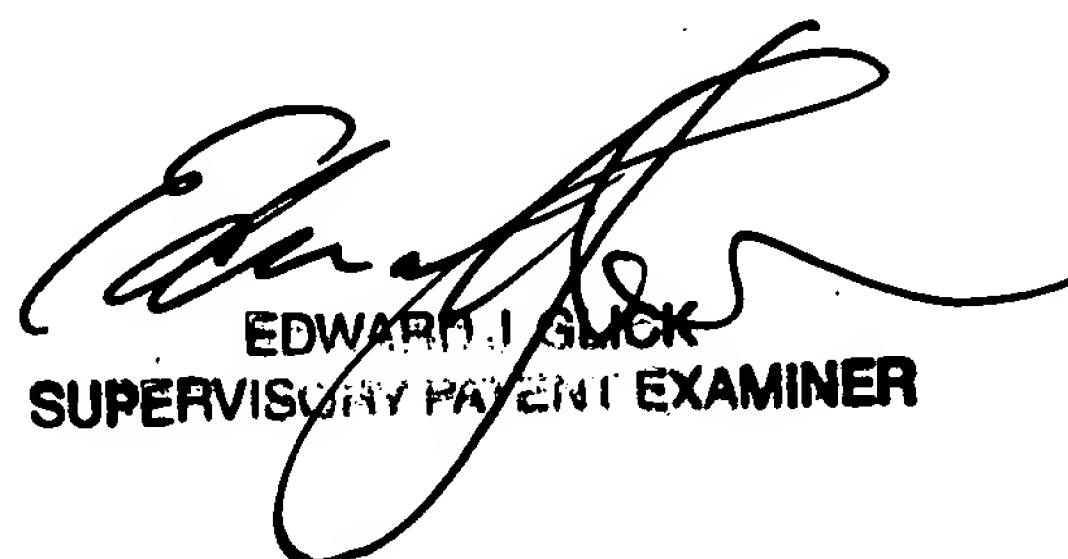
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Glick can be reached on (571) 272-2490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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EDWARD J. GLICK
SUPERVISORY PATENT EXAMINER